



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/986,794	11/13/2001	Yasuhiro Kujirai	35.C15933	6087

5514 7590 08/11/2005

FITZPATRICK CELLA HARPER & SCINTO  
30 ROCKEFELLER PLAZA  
NEW YORK, NY 10112

EXAMINER

PATTERSON, RASHAN OMAR

ART UNIT	PAPER NUMBER
----------	--------------

2622

DATE MAILED: 08/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/986,794

Applicant(s)

KUJIRAI, YASUHIRO

Examiner

Rashan O. Patterson

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☒ Claim(s) 16 and 22 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**TWYLER LAMB**  
**PRIMARY EXAMINER**

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Priority*

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5 and 12 are rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

3. The claim(s) are narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device. The claim(s) must be in one sentence form only. Note the format of the claims in the patent(s) cited. "Regular Type Paper" should be more specifically defined.

Regarding claims 8 and 15, the phrase "said layout means" renders the claim indefinite because it is unclear whether the limitation(s) of this phrase pertains to the first or second layout means.

### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 23-28 and 33 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 23-26 and 33 are drawn to a program that merely manipulates data or an abstract idea, or merely solves a mathematical problem without limitation to a practical application in the technological arts.

In order for a claimed invention to accomplish a practical application it must produce a "useful, concrete and tangible result" *State Street*, 143 F.3d at 1373, 47 USPQ2d at 1601-02 (see MPEP 2106.II.A). A practical application can be achieved through recitation of a "physical transformation outside the computer for which a practical application in the technological arts is either disclosed in the specification or would have been known to a skilled artisan", or "limited to a practical application within the technological arts" (MPEP 2106 IVB2(b)). Currently, claim 16 meets neither of these criteria. In order for the claimed process to produce "useful, concrete and tangible" result, recitation of one of the following elements is suggested:

- i. The manipulation of data that represents a physical object or activity transformed from outside the computer (MPEP 2106 IVB2(b)(i)).
- ii. A recitation of a physical transformations outside the computer, for example in the form of pre or post computer processing activity) MPEP 2106 IVB2(b)(i)).
- iii. A direct recitation of a practical application in the technological arts (MPEP 2106 IVB2 (b)(ii)).

Note: In order for computer programs to be considered statutory, they must be contained on a computer readable medium.

***Claim Rejections - 35 USC § 102***

4. Claims 1, 5-8, 17, 23 and 29 are rejected under 35 U.S.C. 102 (b) as being anticipated by Kohtani et al. (US 5474475).

With regards to claims 1, 17, 23 and 29 Kohtani et al. discloses an information processing apparatus for executing a printing process, comprising: input means (51) for inputting an arbitrary first output paper size included in a predetermined second output paper size and layout means for arranging a plurality of pages of said first output paper size to one page of said second output paper size (Fig. 3, and 6; Col. 9 line 10-14; Col 6 lines 66-67 Col. 7 lines 1-2).

With regards to claims 5, Kohtani et al. discloses an apparatus where in said first output paper size is a user-defined paper size and said second output paper size is a regular type paper size (Col. 2 lines 1-2; Col 6 lines 55-56).

With regards to claim 6, Kohtani et al. discloses an apparatus wherein layout means arranges the plurality of pages of first output paper size to one page of second output paper size without reducing said plurality of pages (Col. 6 line 66- Col 7 line 14).

With regards to claim 7, Kohtani et al discloses an apparatus comprising second layout means for zooming print target data of first paper output size to second paper size reducing N pages (N is equal to 2 or more) of said zoomed print target data, and arranging the reduced print target data of N pages (Col. 9 lines 10-14).

With regards to claim 8 Kohtani discloses an apparatus comprising a designation means for designating whether the layout in said second layout means is executed or the layout in said layout means is executed (Col. 9 lines 64-Col 10 lines 5).

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 2, 4, 9, 11-15, 18, 20, 24, 26, 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kohtani et al. (US 5475475) in view of Stone et al. (US 5768488).

Regarding claim 2, 18, and 24 Kohtani et al. does not disclose an apparatus wherein said layout means arranges the plurality of pages of first output paper size to each of duplex pages of said second output paper size.

Stone et al. discloses an apparatus wherein layout means arranges the plurality of pages of first output paper size to each of duplex pages of said second output paper size (Fig. 3, 4, 5; Col. 5 lines 40-46).

It would have been obvious for one of ordinary skill in the art at the time of the invention to modify Kohtani et al. by Stone et al. to have an apparatus wherein layout means arranges the plurality of pages of first output paper size to each of duplex pages of said second output paper size, as revealed in Figures. 3, 4, 5; Col. 5 lines 40-46, in

order for Kohtani et al. to achieve the arrangement of first output pages on duplex pages.

With regards to claim 4, Kohtani et al. does not disclose wherein said first output paper size is a paper size of print target data in a logical page which is inputted from an application, and said second output paper size is a paper of a recording paper in a physical page which is printed and outputted.

Stone et al. discloses an apparatus, wherein first output paper size is a paper size or print target data in a logical page which is inputted from an application, and said second output paper size is a paper size of recording paper in a physical page which is printer and outputted (Col. 3 lines 53-57).

It would have been obvious for one of ordinary skill in the art at the time of the invention to modify Kohtani et al. by Stone et al. to have an apparatus wherein first output paper size is a paper size or print target data in a logical page which is inputted from an application, and said second output paper size is a paper size of recording paper in a physical page which is printer and outputted, as revealed in Col. 3 lines 53-57, in order for Kohtani et al. to achieve having an apparatus wherein first output paper size is a paper size or print target data in a logical page which is inputted from an application, and said second output paper size is a paper size of recording paper in a physical page which is printer and outputted.

With regards to claim 9, 20, 26 and 30 Kohtani et al. discloses an information processing apparatus for controlling a printing operation, comprising: first input means (51) for inputting an arbitrary first output paper size; second input means (106) for

inputting second output paper size including said first output paper size; layout means for arranging said first output paper sizes of a plurality of pages to a paper of said second output paper size and said second output paper size (Fig. 3, and 6; Col. 9 line 10-14; Col 6 lines 66-67 Col. 7 lines 1-2).

Kohtani et al. does not disclose duplex printing.

Stone et al. discloses an information processing apparatus for controlling a printing operation in a printer which can perform a duplex printing (Fig 9; Col. 5 lines 40-46).

It would have been obvious for one of ordinary skill in the art at the time of the invention to modify Kohtani et al. by Stone et al. to have an apparatus for controlling a printing operation in a printer which can perform a duplex printing, as noted in figure 9 and column 5 lines 40-46, in order for Kohtani et al. to achieve duplex printing.

With regards to claim 11, Kohtani et al. does not disclose an apparatus for controlling a printing operation wherein first output paper size is a paper size of print target data in a logical page which is inputted from an application, and said second output paper size is a paper of a recording paper in a physical page which is printed and outputted.

Stone et al. discloses an apparatus wherein first output paper size is a paper size or print target data in a logical page which is inputted from an application, and said second output paper size is a paper size of recording paper in a physical page which is printer and outputted (Col. 3 lines 53-57).



It would have been obvious for one of ordinary skill in the art at the time of the invention to modify Kohtani et al. by Stone et al. to have an apparatus capable of duplex printing as noted in Fig 9; Col. 5 lines 40-46, and an apparatus wherein first output paper size is a paper size or print target data in a logical page which is inputted from an application, and said second output paper size is a paper size of recording paper in a physical page which is printer and outputted, as revealed in Col. 3 lines 53-57 in order for Kohtani et al to achieve duplex printing and having first output paper size is a paper size or print target data in a logical page which is inputted from an application, and said second output paper size is a paper size of recording paper in a physical page which is printer and outputted.

With regards to claim 12, Kohtani et al. does not disclose an information processing apparatus for controlling a printing operation in a printer which can perform a duplex printing.

Stone et al. discloses an apparatus wherein layout means arranges the plurality of pages of first output paper size to each of duplex pages of said second output paper size (Fig. 3, 4, 5; Col. 5 lines 40-46).

It would have been obvious for one of ordinary skill in the art at the time of the invention to modify Kohtani et al. by Stone et al. to have an apparatus wherein layout means arranges the plurality of pages of first output paper size to each of duplex pages of said second output paper size as revealed in Figures. 3, 4, 5 and Col. 5 lines 40-46, in order for Kohtani et al. to achieve duplex printing.

With regards to claims 13, 14 and 15 Kohtani et al. discloses an information processing apparatus as modified by Stone et al. further comprising a layout means that arranges the plurality of pages of first output paper size to each of duplex pages of said second output pages of said second output paper size (Fig 3,4,5; Col 5 lines 40-46)

4. Claim 3, 19 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kohtani et al. (US 5475475) in view of Busby (US 4254409).

Regarding Claim 3, 19 and 25 Kohtani et al. does not disclose an apparatus wherein said layout means adds a frame line to the page of second output paper size to be arranged.

Busby discloses an apparatus where in said apparatus layout means adds a frame line to the page of said second output paper size to be arranged (Col.14 lines 20-26, 35-36).

It would have been obvious for one of ordinary skill in the art at the time of the invention to modify Kohtani et al. by Busby to have an apparatus where in said apparatus layout means adds a frame line to the page of said second output paper size to be arranged as revealed in Col.14 lines 20-26, 35-36 in order for Kohtani et al. to add a frame line to output paper sizes.

5. Claims 10,21,27 and 31-34 are rejected under 35 U.S.C. 103(a) as being obvious over Kohtani et al. (US 5475475) and Stone et al. (US 5768488), and further in view of Busby (US 4254409).

Regarding claim 10, 21 and 27 Kohtani does not disclose an apparatus where in said layout means adds a frame line to the obverse and reverse of the paper of said second output size.

Stone et al. discloses an information processing apparatus for controlling a printing operation in a printer which can perform a duplex printing (Fig 9; Col. 5 lines 40-46).

Busby discloses an apparatus where in said apparatus layout means adds a frame line to the page of said second output paper size to be arranged (Col.14 lines 20-26, 35-36).

It have been obvious for one skilled in the are at the time of the invention to modify Kohtani et al. by Stone et al. and further by Busby to having an information processing apparatus for controlling a printing operation in a printer which can perform duplex printing as shown in figure 9 and column 5 lines 40-46, and having an apparatus layout means that adds a frame line to the page of said second output paper size to be arranged as revealed in column 14 lines 20-26, 35-36 so that Kohtani et al. can achieve duplex printing and adding a frame line to output paper sizes.

Regarding claim 31, 32, 33, and 34 Kohtani discloses an information processing apparatus for controlling a printing operation, comprising: first input means (51) for inputting an arbitrary first output paper size; second input means (106) for inputting second output paper size including said first output paper size; layout means for arranging said first output paper sizes of a plurality of pages to a paper of said second

Art Unit: 2622

output paper size and said second output paper size (Fig. 3, and 6; Col. 9 line 10-14; Col 6 lines 66-67 Col. 7 lines 1-2).

Kohtani does not disclose an information processing apparatus for controlling a printing operation in a printer which can perform a duplex printing; a control means for drawing a frame line corresponding to each page of said first output paper size onto a reverse of a paper size on which data arranged by said layout means is drawn.

Stone et al. discloses an information processing apparatus for controlling a printing operation in a printer which can perform a duplex printing (Fig 9; Col. 5 lines 40-46).

Busby discloses a control means for drawing a frame line corresponding to each page of said first output paper size onto a reverse of a paper size on which data arranged by said layout means is drawn (Col.14 lines 20-26, 35-36).

It have been obvious for one skilled in the are at the time of the invention to modify Kohtani et al. by Stone et al. and further by Busby to having an information processing apparatus for controlling a printing operation in a printer which can perform duplex printing as shown in figure 9 and column 5 lines 40-46, and having a control means for drawing a frame line corresponding to each page of said first output paper size onto a reverse of a paper size on which data arranged by said layout means is drawn revealed in column 14 lines 20-26, 35-36 so that Kohtani et al. can achieve duplex printing and drawing a frame line to output paper sizes.

Regarding method claim 32, the structural elements of apparatus 21 perform all of the method steps of claim 32. Therefore method claim 32 is rejected for the same reason as set forth in the rejection of apparatus claim 31.

Regarding claims 33 and 34, the program steps of the program claim 33 are the same steps as those of method claim 32. Therefore program claims 33 and 34 are rejected for the same reason as set forth in method claim 32

### ***Allowable Subject Matter***

6. Claims 16, 22, and 28 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Reason of Allowance***

The prior art of record does not render obvious the unique combination: "an apparatus comprising second designating means for performing the addition of the frame line in said layout means only to the reverse of the paper of said second output paper size, and wherein said layout means adds the frame line only to the reverse of the paper of said second output paper size in accordance with designation of said second designation means;" "a method comprising a designating step of performing the addition of the frame line in said layout step only to the reverse of the paper of said second output paper size, and wherein in said layout step the frame line is added only

to the reverse of the paper of said second output paper size in accordance with designation in said second designating step;" " a program comprising a designating step of performing the addition of the frame line in said layout step only to the reverse of the paper of said second output paper size and wherein in said layout step, the frame line is added only to the reverse of the paper of said second output paper size in accordance with the designation in said second designating step."

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hasegawa (US 5537518) reveals a document processing system that is capable of forming document data adapted to be printed on printing sheets having a first predetermined size. Rigau Rigau et al. (US 5745659) shows an apparatus that can scale a drawing which is calibrated to fit a source print media with a first size, scaled to fit a destination print media with a second size. Rackley et al. (US 4342052) discloses an apparatus capable of reducing more than one copy to a single copy. Rourke (US 5191429) shows an apparatus capable of printing multiple up images onto a sheet of paper. Deen et al. (US 5838325) discloses a device capable of manipulating and printing a plurality of images on an output paper size.

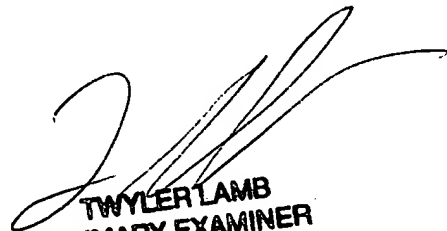
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rashan O. Patterson whose telephone number is 571-272-0597. The examiner can normally be reached on Mon - Fri 9am-5pm.

Art Unit: 2622

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ed Coles can be reached on 571-272-7402. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ROP



TWYLER LAMB  
PRIMARY EXAMINER